

IN THE DRAWINGS:

The attached drawing sheets 1, 2, and 3 include amendments to Figs. 1-5 and replace the corresponding drawing sheets of the Application.

Attachment: Replacement Drawing Sheets 1, 2, and 3 including amended Figs. 1-5.

## REMARKS

Applicants add new claims 16-19 such that claims 1-19 are pending in this application. Applicants respectfully request allowance of all the pending claims.

### CLAIMS 1-8

The Examiner rejects claims 1-4, 6, and 8 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,857,538 (“Chambers”) in view of U.S. Patent No. 4,735,277 (“Prince”). The Examiner rejects claim 5 under 35 U.S.C. §103(a) as being unpatentable over Chambers as modified by Prince in view of United States Patent No. 4,828,069 (“Hatsuyama”), and the Examiner rejects claim 7 under 35 U.S.C. §103(a) as being unpatentable over Chambers as modified by Prince in view of French Patent No. 1020216 (“Bernard”).

Claim 1 recites a motorcycle including a frame and an engine/transmission assembly mounted to said frame and having an output shaft rotating in response to the operation of the engine/transmission assembly. A drive sprocket is mounted to the output shaft for rotation with the output shaft. A swingarm is pivotably mounted to the frame or the engine/transmission assembly for pivotal movement within a range of motion. A rear wheel is mounted to the swingarm for rotation and a wheel sprocket is mounted to the rear wheel for rotation with the rear wheel. A flexible drive member couples the drive sprocket and the wheel sprocket such that the rear wheel is caused to rotate in response to the operation of the engine/transmission assembly. The flexible drive member includes an upper extent linearly extending between the upper portions of the drive sprocket and the wheel sprocket, and a lower extent extending between the lower portions of the drive sprocket and the wheel sprocket. A tensioner is fixed to the frame or the engine/transmission assembly against both pivotal and translational movement with respect to the output shaft. The tensioner maintains contact with a side of the lower extent and applies a force to the side of the lower extent as the swingarm pivots through the range of motion. The drive sprocket, the wheel sprocket, and the tensioner are sized and positioned such that a belt path length defined by the drive sprocket, the rear sprocket, and the tensioner remains substantially constant as the swingarm pivots through the range of motion.

Chambers discloses a motorcycle (10) having engine operably coupled to the rear wheel (58) by a chain (11). In Figs. 9 and 10, the motorcycle includes a tensioner (not identified) that contacts the lower extent of the chain (11). As stated by the Examiner, Chambers does not teach

or suggest a tensioner that is fixed to the frame or the engine/transmission assembly against both pivotal and translational movement with respect to the output shaft.

To cure this particular deficiency of Chambers, the Examiner asserts that Prince discloses a tensioner coupled to the frame against both pivotal and translational movement with respect to an output shaft of the engine. However, Prince merely discloses that “[a]n idler arm 1100 is mounted on shaft 1104 and has idler roller 1102 fixed thereon for controlling the tension in the chain 930.”

Applicants respectfully disagree with the Examiner and assert that Prince does not describe a fixed chain tensioner or a method of operating a fixed chain tensioner anywhere within its specification. Instead, one of ordinary skill in the art would understand that the tensioner (1100, 1102) described in Prince is biased to pivot against the chain (930) about the pivot shaft (1104). In support of this position, Applicants direct the Examiner’s attention to the attached Rule 1.132 Declaration of Dane J. Hoechst, which provides reasons why the illustrated chain tensioner could not be a fixed tensioner as described by the Examiner.

If the Examiner disagrees with the arguments presented in this Amendment, Applicants respectfully request the Examiner to identify within Prince where it discloses a tensioner that is fixed to the frame or the engine/transmission assembly against both pivotal and translational movement with respect to the output shaft.

For the reasons stated above, Chambers and Prince, alone or in combination, do not teach or suggest the subject matter defined by independent claim 1. Accordingly, independent claim 1 is allowable. Claims 2-8, 16, and 17 depend from allowable independent claim 1 and are allowable for the same and other reasons.

For example, new claim 16 recites that the tensioner is mounted to at least one of the engine/transmission assembly and frame at multiple connection points. In addition, new claim 17 recites that the tensioner is mounted to at least one of the engine/transmission assembly and frame with multiple fasteners.

Chambers and Prince, alone or in combination, do not teach or suggest using multiple connection points or multiple fasteners to mount the tensioner to the engine/transmission assembly or to the frame. Rather, Chambers discloses a single mounting point and a single fastener to mount the tensioner to the frame and Prince discloses a single mounting point (i.e.,

shaft 1104) and a single fastener to mount the idler arm (1100) to the frame. Therefore, Chambers and Prince do not teach or suggest the subject matter of claims 16 or 17.

The subject matter of claims 16 and 17 was added to the specification in the second full paragraph of page 4. Applicants submit that this addition is not new matter because the multiple connection points (39) and the multiple fasteners (41) were disclosed in the originally-filed drawings. Applicants note that “information contained in any one of the specification, claims, or drawings of the application as filed may be added to any other part of the application without introducing new matter.” MPEP 2163.06. The multiple connection points and fasteners were disclosed in the originally-filed Fig. 2.

#### CLAIMS 9-15

The Examiner rejects claims 9, 10, 12, 14, and 15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,857,538 (“Chambers”) in view of U.S. Patent No. 4,735,277 (“Prince”). The Examiner rejects claim 11 under 35 U.S.C. §103(a) as being unpatentable over Chambers as modified by Prince in view of Hatsuyama, and the Examiner rejects claim 13 under 35 U.S.C. §103(a) as being unpatentable over Chambers as modified by Prince in view of Bernard.

Claim 9 recites a method for tensioning a motorcycle flexible drive member. The method includes providing a motorcycle frame and a swingarm and mounting an engine/transmission assembly to the motorcycle frame. The engine/transmission assembly includes an output shaft rotating about an axis of rotation in response to operation of the engine/transmission assembly. The method also includes mounting a drive sprocket to the output shaft for rotation therewith, mounting a rear wheel to the swingarm for rotation with respect to the swingarm, mounting a wheel sprocket to the rear wheel for rotation therewith, pivotably interconnecting the swingarm with at least one of the frame and engine/transmission assembly to permit pivotable movement of the swingarm in a range of motion about a pivot axis that is non-collinear with the axis of rotation of the output shaft, and coupling the drive sprocket and the wheel sprocket with a flexible drive member such that the rear wheel rotates in response to rotation of the output shaft and such that an upper extent of the flexible drive member linearly extends between the upper portions of the drive sprocket and the wheel sprocket. The method further includes mounting a tensioner to at least one of the engine/transmission assembly and frame such that the tensioner

contacts a side of a lower extent and applies a force to the side of the lower extent, fixing the tensioner against translational and pivotable movement with respect to the engine/transmission assembly and frame, pivoting the swingarm through the range of motion while maintaining a substantially constant belt path length defined by the drive sprocket, the wheel sprocket, and the tensioner, and maintaining contact between the side of the lower extent and the tensioner such that the tensioner applies a force to the side of the lower extent as the swingarm pivots through the range of motion.

As stated above, Applicants respectfully disagree with the Examiner and assert that Prince does not describe a fixed chain tensioner or a method of operating a fixed chain tensioner anywhere within its specification. Instead, one of ordinary skill in the art would understand that the tensioner (1100, 1102) described in Prince is biased to pivot against the chain (930) about the pivot shaft (1104). In support of this position, Applicants direct the Examiner's attention to the attached Rule 1.132 Declaration of Dane J. Hoechst, which provides reasons why the illustrated chain tensioner could not be a fixed tensioner as described by the Examiner.

If the Examiner disagrees with the arguments presented in this Amendment, Applicants respectfully request the Examiner to identify within Prince where it discloses a tensioner that is fixed to the frame or the engine/transmission assembly against both pivotal and translational movement with respect to the output shaft.

For the reasons stated above, Chambers and Prince, alone or in combination, do not teach or suggest the subject matter defined by independent claim 9. Accordingly, independent claim 9 is allowable. Claims 10-15, 18, and 19 depend from allowable independent claim 9 and are allowable for the same and other reasons.

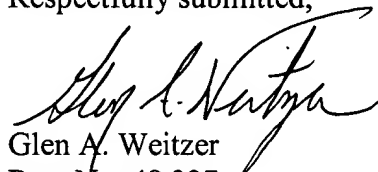
For example, new claim 18 recites mounting the tensioner at multiple connection points and new claim 19 recites mounting the tensioner with multiple fasteners.

As discussed above with respect to claims 16 and 17, Chambers and Prince, alone or in combination, do not teach or suggest using multiple connection points or multiple fasteners to mount the tensioner to the engine/transmission assembly or to the frame. Rather, Chambers discloses a single mounting point and a single fastener to mount the tensioner to the frame and Prince discloses a single mounting point (i.e., shaft 1104) and a single fastener to mount the idler arm (1100) to the frame. Therefore, Chambers and Prince do not teach or suggest the subject matter of claims 18 or 19.

The subject matter of claims 18 and 19 was added the specification in the second full paragraph of page 4. Applicants submit that this addition is not new matter because the multiple connection points (39) and the multiple fasteners (41) were disclosed in the originally-filed drawings. Applicants note that "information contained in any one of the specification, claims, or drawings of the application as filed may be added to any other part of the application without introducing new matter." MPEP 2163.06. The multiple connection points and fasteners were disclosed in the originally-filed Fig. 2.

The Examiner is invited to contact the undersigned attorney should the Examiner determine that such action would facilitate the prosecution and allowance of the present application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Glen A. Weitzer", is written over the printed name and registration number.

Glen A. Weitzer  
Reg. No. 48,337

Docket No.: 18470-9053-00  
Michael Best & Friedrich LLP  
100 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-4108

(414) 271-6560